

### **REMARKS/ARGUMENTS**

Claims 20, 24, 35, 37, 50, 51 and 53-55 are pending in this application. No claims have been amended, added, or cancelled with the filing of this response. Reconsideration is requested in view of the following remarks.

#### **Rejection under 35 U.S.C. § 102(b)**

The rejection of claim 53 under 35 U.S.C. § 102(b) as anticipated by Chivukula (US Patent No. 6,066,581) is respectfully traversed for reasons of record and the reasons discussed below.

As provided in MPEP 2113, “[t]he structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product.”

In the present case, as previously pointed out in the Response filed January 9, 2009, the Office has not shown and the reference does not indicate the description of a dielectric thin film with a relative dielectric constant greater than 10 *consisting essentially of* the components of claim 37, in which claim 53 is dependent from claim 37.

In particular, Chivukula generally describes a *sol-gel* precursor mixture for forming a perovskite ferroelectric material and other various physical processes for forming the material, which is entirely different from the present claims and description. By contrast, as described in the present specification, the resulting grains of the present claims are significantly different than those formed by physical deposition processes and sol-gel processes, as described in the present specification at page 11, lines 1-13. Therefore, for at least this reason, claim 53 is not anticipated or obvious by the references of record. Accordingly, reconsideration and withdrawal of the rejection is requested.

**Rejections under 35 U.S.C. § 103**

The rejection of claims 20, 24, 35, 37, 50, 51, 53-55 are rejected under 35 U.S.C. § 103(a) as obvious over Leung (US Published Patent Appl. No. 2002/0137260) in view of Matijevic (US Patent No. 5,900,223); and the rejection of claim 54 as obvious over Leung in view of Matijevic and further in view of Yokouchi (US Patent No. 5,143,637) are respectfully traversed for reasons of record and the reasons discussed below.

Regarding obviousness, it is well known that rejections under §103(a) must comply not only with the statutory provisions of §103, but also with the controlling case law. As was recently reaffirmed by the U.S. Supreme Court, *Graham v. John Deere Co. of Kansas City* sets out the controlling factual inquiries that must be made when considering and making a determination of obviousness under Section 103(a). (*See, KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734-1740 (2007), citing *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966); *see also* MPEP §2141, informing that it is Office policy to follow the teachings of *Graham*.) The four *Graham* factual inquiries include:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

When determining the scope and contents of the prior art, the Office must consider the prior art in its entirety, including any disclosure that would lead away from the claimed invention. (*See, W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (indicating that prior art references must be considered in their entirety, as a whole, including any disclosures that lead away from the claims at issue.))

In the present case, as discussed previously in the Response filed January 9, 2009, the present claims clearly differ from the references of record, since Leung does not describe, *inter alia*, any surfactant-coated nanoparticles, and Matijev does not describe surfactant coating (or relate to the matrix material infiltration Leung) that would result in the claimed dielectric thin film having the above-recited components. Further, Yokouchi relates to a low-viscosity magnetic fluid, in which one skilled in the art would not look to or rely on such a disclosure to

cure the deficiencies of any of the references. Therefore, the present claims are novel and unobvious of the references of record. Accordingly, withdrawal of the rejections is requested.

In view of the above remarks, Applicant believes the pending application is in condition for allowance.

In the event the Examiner believes an interview might serve in any way to advance the prosecution of this application, the undersigned is available at the telephone number noted below.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0510, under Order No. YOR920010225-US2 from which the undersigned is authorized to draw.

Dated: September 23, 2009

Respectfully submitted,

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